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PATENT APPLICATION
10/516,534

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Wolfgang Hahn et al.
Serial No.:	10/516,534
Date Filed:	December 2, 2004
Group Art Unit:	2618
Confirmation No.:	4504
Examiner:	Nguyen, Simon
Title:	METHOD AND DEVICE FOR AUTHENTICATING A SUBSCRIBER FOR UTILIZING SERVICES IN WIRELESS LAN (WLAN)

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST ARGUMENTS

This Application has been carefully reviewed in light of the Final Office Action mailed January 29, 2009 (“Final Office Action”). At the time of the Final Office Action mailed January 29, 2009, Claims 1-26 were pending in this Application. Claims 1-26 were rejected. No claim amendments are hereby requested. This Request is being filed concurrently with a Notice of Appeal.

ARGUMENTS

Claims 1-21 and 23-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2003/0169713 filed by Hui Luo ("*Lou*") in view of U.S. Patent Publication 2003/0027595 filed by Richard Paul Ejzak ("*Ejzak*"). Applicants respectfully traverse and submit the proposed combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lou* in view of *Ejzak* as applied to Claim 1 above, and further in view of U.S. Patent Publication 2002/0136226 filed by Thomas W. Christoffel et al. ("*Christoffel*"). Applicants respectfully traverse and submit the proposed combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Applicants contend that the rejections of Claims 1-26 under 35 U.S.C. § 103(a) on prior art grounds contain clear legal and factual deficiencies, as described below.

The claims of this application generally cover a device and method that can efficiently authenticate a subscriber of a wireless LAN (WLAN) who is also a mobile radio network subscriber, while utilizing services in a mobile radio network (e.g., GSM or UMTS). One of ordinary skill in the art would understand that an IP multimedia system is used to authenticate a subscriber of the mobile radio network.¹ One aspect of Applicants' disclosure is that an IP multimedia subsystem is used for authenticating the subscriber within the WLAN. This differs from the traditional use of an IP multimedia subsystem, which is to authenticate the subscriber within a mobile radio network (e.g., GSM or UMTS).

Thus, the distinction between the two types of networks, i.e., WLAN and mobile radio network, is important in Applicants' invention. Applicants respectfully submit that the Examiner has failed to appreciate or recognize this distinction. In fact, in the Final Office Action, the Examiner uses the two different types of networks interchangeably, substituting a WLAN for a mobile radio network (and vice versa) in order to read the claims on the prior

¹ Applicants direct the Examiner to Applicants' Pre-Appeal Brief filed September 27, 2007, Page 2, where Applicants discussed what one of ordinary skill in the art would understand the term "IP multimedia subsystem" to mean—i.e., an architectural framework for use in mobile radio networks.

art. For example, the Examiner considers *Luo*'s "WLAN subnet 104 . . . as [the] IP multimedia subsystem." (Final Office Action, Page 4; *see also* Page 3: "[T]he web authentication server in the combination of other devices such as server 110, 112, controller 116, mobile state database 108 act as an IP multimedia subsystem for the WLAN subnets in a large scale WLAN network 100.") As just discussed, one of skill in the art would understand the IP multimedia system to be a component of a mobile radio network, not a WLAN. Thus, the Examiner's regarding a WLAN subnet as an IP multimedia subsystem ignores the distinction between a WLAN and a mobile radio network, as recited in, for example, independent Claim 1.

Similarly, in the Final Office Action the Examiner considers *Ejzak*'s "radio area network . . . as a wireless LAN [WLAN]." (Final Office Action, Page 5; *see also* Page 3: "[T]he RAN is considered (inherently) as a WLAN.") Again, Applicants respectfully submit that substituting a radio area network (i.e., a mobile radio network) with a WLAN is improper and ignores the very object of Applicants' disclosure, which is to efficiently authenticate a subscriber of a WLAN who is also a mobile radio network subscriber.

Further, to the extent the Examiner relies on an alleged "inherent" teaching in *Ejzak* (i.e., that the RAN is "inherently" a WLAN), Applicants respectfully note that in order to rely on the theory of inherency, § 2112 of the Manual of Patent Examining Procedure requires that the Examiner "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added) (citations omitted). Applicants submit that the Examiner has failed to provide the requisite basis for concluding that *Ejzak*'s RAN is interchangeable with a WLAN, and for this reason, the Examiner's failure to recognize the distinction between the two types of networks is improper.

Under a proper analysis wherein a distinction between a WLAN and mobile radio network is made, Applicants respectfully submit that the rejections of Claims 1-26 are not proper for the reasons described in Applicants' Response dated October 22, 2008, at Pages 8-

10.² *Luo* does not disclose a mobile radio network, an IP multimedia subsystem, or as the Examiner has agreed, registration based on SIP registration. Thus, *Luo* fails to disclose “using the IP address by the subscriber to authenticate the subscriber to the IP multimedia subsystem of the mobile radio network by means of a session initiation protocol (SIP) registration,” as recited in independent Claim 1. Moreover, although *Ejzak* discloses an IP multimedia subsystem, it fails to disclose “authenticat[ing] the subscriber to the IP multimedia subsystem,” as recited in independent Claim 1. Rather, *Ejzak* explicitly discloses that the Serving GPRS Support Node (SGSN) performs authentication. (See [0026].) *Ejzak* is clear that the SGSN is in the packet-switched domain 131 part of the disclosed mobile radio network, (see [0026], fig. 1), which is separate and distinct from the IP multimedia subsystem 141. (See [0022], fig. 1.) Thus, both *Luo* and *Ejzak* fail at least to disclose “using the IP address by the subscriber to authenticate the subscriber to the IP multimedia subsystem of the mobile radio network by means of a session initiation protocol (SIP) registration.”

Independent Claim 23 recites a similar limitation: “an IP multimedia system for authenticating a subscriber to be authenticated by means of a session initiation protocol (SIP) registration” Applicants respectfully submit that *Luo* and *Ejzak*, separately or combined, fail to disclose this limitation for the same reasons presented above with respect to Claim 1.

In addition to the failure of the prior art to disclose all limitations of Claims 1-26, the Examiner has not provided rationales for combining the cited references as required by applicable law and the M.P.E.P. Even if each limitation is disclosed in a combination of references, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must

² It is noted in the *Official Gazette* Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that “Applicants are encouraged to refer to arguments already of record rather than repeating them in the request.” Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In the present case, the Examiner makes a conclusory statement that *Luo* and *Ejzak* can be combined because “both *Luo* and *Ejzak* disclose the method and apparatus for authenticating of the IP address of the mobile unit in the WLAN in order to allow the mobile unit to access the IP multimedia information in the mobile network.” (Final Office Action, Page 3.) Applicants respectfully submit that this conclusion again improperly relies on the assumption that a mobile radio network and WLAN are interchangeable. To be sure, *Luo* discloses only a large-scale WLAN network. (See, e.g., Abstract, [0014], fig. 1.) In particular, *Luo* discloses that the large scale WLAN network is made up of a plurality of WLAN subnets. (See [0019].) However, *Luo* does not disclose an IP multimedia subsystem or a mobile radio network (e.g., GSM, UTMS, etc.). Although the Examiner considers *Luo*’s “WLAN subnet 104 . . . as [the] IP multimedia subsystem” (Final Office Action, Page 4), nothing in *Luo* teaches or suggests that this is so. In addition, nothing in *Luo* hints at using the disclosed WLAN along with an IP multimedia system of a mobile radio network because *Luo* is not concerned with mobile radio networks. Similarly, *Ejzak* fails to disclose a WLAN, as it only discloses a mobile radio network. (See, e.g., Abstract, [0020], [0021], fig. 1.) Nothing in *Ejzak* teaches or suggests that it would be possible—or even desirable—to use the disclosed mobile radio network with a WLAN.

When read in light of the distinction between the two types of networks, *Luo* merely teaches a method of authentication in a WLAN network—i.e., a network that does not include an IP multimedia subsystem or a mobile radio network. Further, *Ejzak* merely teaches a method of authentication in a mobile radio network that includes an IP multimedia subsystem. Neither reference, however, teaches or provides any motivation to combine the two different technologies. As such, the only support for the combination suggested by the Examiner, or for that matter, the only discussion of how to make such a combination work is found in the present application. However, combining references based on Applicants’ disclosure is improper, as the rationale for combining references must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

Thus, the Examiner's statements are not sufficient to support a finding of obviousness because "[t]he key to supporting any rejection under 35 U.S.C. [§] 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2143 (emphasis added). In this case, the Examiner attempts to show that there was some teaching, suggestion, or motivation for the proposed combination of *Luo* and *Ejzak* by stating that this combination would have been obvious "to improve the registration procedure in order to secure the system accessing." (Final Office Action, Page 5). This statement, however, ignores the fact that *Luo* explicitly discloses a "zero-configuration secure mobility networking technique." (See Abstract (emphasis added).) Because *Luo* already discloses secure network access, resort to *Ejzak* "in order to secure the system accessing" would be unnecessary. Similarly, the Examiner attempts to show that the combination of *Luo* and *Ejzak* would have been obvious because "the SIP registration . . . will provide more security and privacy to users than a conventional registration." (Final Office Action, Page 4.) Respectfully, the Examiner has failed to show that there is a lack of security or privacy in the registration technique disclosed in *Luo*. Thus, the Examiner has failed to properly show that there was some teaching, suggestion, or motivation in *Luo* or *Ejzak* for modifying or combining the references.

Nor has the Examiner shown knowledge generally available to one of skill in the art to modify the references or to combine reference teachings. The Examiner is respectfully reminded that any findings must be supported by documentary evidence in the record. 37 C.F.R. § 1.104(e)(2); M.P.E.P. § 2144.03(C). The Examiner is also respectfully reminded that if the Examiner relies on personal knowledge to support a finding of what is known in the art, such finding must be supported with an affidavit or declaration setting forth specific factual statements and explanation to support the finding. 37 C.F.R. § 1.104(d)(2); M.P.E.P. § 2144.03(C). In light of the Examiner's failure to establish a prima facie case and provide necessary documentary evidence of obviousness, Applicants submit that Claims 1-26 may not be rendered obvious.

For at least the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 1-26.

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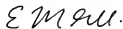
Applicant respectfully requests revision of the Attorney Docket No. in the United States Patent Office records. Please replace with Attorney Docket No. 03869.105891.

CONCLUSION

Applicants submit this Argument in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicants authorize the Commissioner to charge Deposit Account No. 50-4871 in the amount of \$540.00 for the Notice of Appeal fee and \$130.00 for the Petition for a One-Month Extension of Time. Applicants believe there are no further fees due at this time; however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of King & Spalding LLP.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2030.

Respectfully submitted,
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Date: May 19, 2009

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